

RESPONSE UNDER 37 C.F.R. § 1.111

Application No.: 09/817,048

Attorney Docket No.: Q63719

Group Art Unit No.: 3676

registration address throughout each transaction in addition to the customary transaction files generated by Roach.

First, Applicants respectfully remind the Examiner that the USPTO is held to a rigorous standard when trying to show that an invention would have been obvious in view of the combination of two or more references. *See, In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), citing, e.g., *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”). In *Lee*, the Federal Circuit further emphasized that the “need for specificity pervades this authority.” (*Lee* at 1433 (citing *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”))). The factual inquiry into whether to combine references “must be based on objective evidence of record.” *Lee* at 1433. In this case, the Examiner has pointed to no teaching or motivation to combine the references, but has simply stated that it “would have been obvious to modify the system of Roach et al. by also generating a URL or registration address throughout each transaction in addition to the customary transaction files generated by Roach.” This analysis and conclusion, however, fall well short of the particular findings required by *Lee*. Therefore, Applicants respectfully submit that the Examiner has provided no motivation in the rejection for making the combination of Roach et al. and Robinson.

Further, one claimed feature of the invention is that “said transmission element of said salesclerk terminal transmits, in addition to said order information, a registration address” as recited in claim 1. That is, the salesclerk terminal transmits a combination of the order information and a registration address. Analogous features are also recited in each of the other independent claims.

In the Office Action at page 2 , the Examiner states that “Roach et al. teach a product ordering system comprising a salesclerk terminal (point of sale terminal), an order reception system (main processor) and a shop ordering system (warehouse processor), wherein the main processor and warehouse processor communicate to process the order by receiving the order, generating and registering the order info and ID, and transmitting to each other and the sales terminal.” In the Office Action at page 3, the Examiner acknowledges that “they (Roach et al.) fail to specifically teach generating a registration address or URL between the sales terminal, order reception system, and shop ordering system.

Applicants respectfully submit that both Roach et al. and Robinson do not disclose or suggest the aforementioned feature of the present invention. In particular, in the present invention, the salesclerk terminal transmits a combination of the order information and a registration address. The personal computers and Compuserve system referred to by the Examiner in Roach et al. are not point of sale terminals that would be considered as a salesclerk terminal of the present invention. Moreover, as shown in Figure 1 of Roach et al., system 48 is a separate system (a computer system). There is no motivation that the point of sale terminal in Roach et al. would transmit a combination of the order information and a registration address

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Further, Robinson at col. 7, lines 63-67 discloses that the URLs are used in general communication between two computers, a customer computer 96 and a merchant computer 98. That is, the customer computer 96 may transmit the URL of the customer computer 96 to the merchant computer 98. However, Robinson does not disclose that the customer computer 96 transmits a URL other than the URL of customer computer 96. As such, Robinson also does not provide motivation that the point of sale terminal in Roach et al. would transmit a combination of the order information and a registration address.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE

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CUSTOMER NUMBER

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